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| 10/527,873 | 07/19/2005 | Gabriele Cruciani | P-2564 | 2043 |
| 2120 7590 08/18/2010 PAUL A. FATTIBENE FATTIBENE & FATTIBENE 2480 POST ROAD SOUTHPORT, CT 06890 | | | | |
| EXAMINER | | | | |
| LEIVA, FRANK M | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,873

Applicant(s)

CRUCIANI, GABRIELE

Examiner

FRANK M. LEIVA

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Acknowledgements

1. The examiner acknowledges amendments to claims 23 and 27 in applicant's submission filed 24 May 2010.

Response to Arguments

2. Applicant's arguments filed 24 May 2010 have been fully considered but they are not persuasive for the following reasons.
3. The argument on page 5 of applicant's remarks directed to the amendment of claims 23 and 27, is not persuasive, the substitution of "substantially" to a "portion" does not describe figure 6 in detail and continues to be ambiguous.
4. Regarding the argument on page 8 of applicant's remarks "*The advantage of the present invention is that by placing and fixing the sensor in the middle of the ball, the location of the ball can very accurately be detected. If the sensor is placed on the circumference of the ball as taught in the prior art King, Jr., the ball can only be accurately located to within one diameter of the ball.*" The examiner notes that the statement is not within the scope of that claim since the claims do not state that the sensor is placed in the middle of the ball, and that a portion of the area could be as little as less than 1%, making it close to the exterior wall.
5. The remarks filed are directed to unclaimed subject matter, such as a rough game or rugged more reliable, or accessibility from the outside. Non of which are claimed limitations. The structure of the ball holding an apparatus in the center by portions of a bladder as claimed is there, and the use of passive sensors inside balls in sport games is there.
6. For the reasons stated above the examiner deems the arguments not persuasive and the previous rejections proper.

Claim Objections

7. Claims 23 and 27 are objected to because of the following informalities: The phrase "The occurrence of a goal" can be misunderstood as lacking antecedent, since "an occurrence" has not been stated earlier, even though the examiner views it as the act of the goal occurring, for the benefit of prosecution the examiner would like the term amended. Also the term "goal" could be interpreted as any event sensed by the sensor, (i.e. trigger event, hit, or movement), since "goal" is not defined in the claim language. Appropriate correction is required.

Claim Rejections - 35 USC § 112 1st paragraph

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. **Claims 23-27** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Both independent **claims 23 and 27** include the limitations a bladder placed "within said external spherical covering and conforming to a portion of the internal surface". Having found no support to the limitations other than what is seen on figure 6 of the drawings, the examiner deems that broad language has been used to describe the figure and that more than what is apparent in the drawing is described. Conforming to a portion is not just what is observed on figure 6, only conforming to one half of the spherical surface, and two bladders not bladder portions, when inflated will support the sensor.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 23-26 are rejected under 35 U.S.C. 112, second paragraph, independent claim 23 as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted element is: "*a chord between said first bladder portion;*" The phrase "between" must be accompanied with the two objects limiting the statement, to understand that one object is the said first bladder portion, the second object not mentioned.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over King Jr. (US 2002/0054905 A1) in view of Spector (RE. 30,103) Reissue of US Patent no. 4,015,111.

13. Regarding the analogous art combination; King Jr. discloses a method of tracking a ball on a court to assess the passing of the ball through the goal line, including imbedding sensor/transmitters inside the ball; Spector discloses a method of imbedding an electronic device inside a ball by pressing it between two bladders inside the ball and holding the device in a central position inside the ball or globe. Both references teach of imbedding a device inside a ball.

14. Regarding claim 23; King Jr. discloses an electronically detectable ball usable for a ball game, (¶ [0037]), comprising an external covering having an internal surface (figs. 8-10);

a device (passive detectable electronic location sensor), (figs. 8-10, ¶ [0040]), whereby said passive detectable electronic location sensor is securely held in position, (figures 8-12) and is adapted to be detected and the occurrence of a goal is capable of being confirmed, (¶ [0008]).

King Jr. is silent about a first or second bladder, whereas Spector discloses:

a first bladder portion placed within said external covering and conforming to a portion of the internal surface of said external covering, (fig. 2);

a second bladder portion placed within said external covering conforming to a portion of the internal surface and extending along a chord between said first bladder portion, (fig. 2); and

a device (passive detectable electronic location sensor) fixed to said second bladder portion, (fig. 2).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention after reading Spector's disclosure, to enhance the ball transmitter device of King Jr. located in the outer skin of the ball with one located in the center of the ball. Using the known technique of holding a device in the center of a ball as in Spector, would allow for the invention to be used in professional sports where a exterior sensor would interfere with the playing and stability of the game ball. It would have been an obvious predictable result to one of ordinary skill, to implement any and all methods of inserting a sensor/transmitter including the use of a well known passive sensor, yielding a predictable result.

15. Regarding claim 24; Spector further discloses said passive detectable electronic location sensor is located midway along the chord (straps), (col. 4:1-2).

16. Regarding claim 25; Spector further discloses the chord comprises a diameter, (col. 3:54-63).

17. Regarding claim 26; Spector further discloses said device (passive detectable electronic location sensor), is located midway along the diameter and at the center of the electronically detectable ball, (col. 3:54-63).

18. Regarding claim 27; King Jr. discloses an electronically detectable ball usable for a ball game, (¶ [0037], fig. 8), comprising a passive detectable electronic location sensor (device); whereby said passive detectable electronic location sensor (device), is securely held in position, (fig. 8-12) and is adapted to be detected and the occurrence of a goal is capable of being confirmed, (figs. 8-10, ¶ [0008] and [0040]);

King Jr. is silent about a first or second bladder, whereas Spector discloses:

an external spherical covering having an internal spherical surface, (fig. 2);

a bladder placed within said external spherical, covering and conforming to the internal spherical surface of said external spherical covering, (fig. 2);

a device (sensor) support extending along a diameter of the internal spherical surface and formed by said bladder, (fig. 2); and

a device (passive detectable electronic location sensor) formed into and fixed inside said device (sensor) support substantially midway along the diameter, (fig. 2).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention after reading Spector's disclosure, to enhance the ball transmitter device of King Jr. located in the outer skin of the ball with one located in the center of the ball. Using the known technique of holding a device in the center of a ball as in Spector, would allow for the invention to be used in professional sports where a exterior sensor would interfere with the playing and stability of the game ball. It would have been an obvious predictable result to one of ordinary skill, to implement any and all methods of inserting a sensor/transmitter including the use of a well known passive sensor, yielding a predictable result.

19. The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed" *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571)272-2460. The examiner can normally be reached on 11:00AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on 5712724690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melba Bumgarner/
Supervisory Patent Examiner, Art Unit 3714

/F. M. L./
Examiner, Art Unit 3714